

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY K. ACKER

Appeal No. 2004-1332
Application No. 10/010,691

ON BRIEF

Before GARRIS, WARREN, and KRATZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-13 which are all of the claims in the application.

The subject matter on appeal relates to a demand hot water recirculation system. With reference to the Appellant's drawing, the system comprises a hot water source 12, at least one plumbing fixture 18 having a hot water inlet, a conduit 26, 24 for enabling circulation of hot water from the source to the plumbing fixture and return to the hot water source, a pump 30 for circulating hot water through the conduit, a switch 36 for generating control

Appeal No. 2004-1332
Application No. 10/010,691

signals and a controller 40, responsive to a plurality of control signals, for activating the pump based on a statistical analysis of control signal timing. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

1. A demand hot water recirculation system comprising:

a hot water source;

at least one plumbing fixture having a hot water inlet;

a conduit, in fluid communication with said hot water source and the plumbing fixture hot water inlet, for enabling circulation of hot water from said hot water source to the plumbing future [sic, fixture] and return to said hot water source;

a pump for circulating hot water through the conduit;

a switch for generating control signals; and

a controller, responsive to a pluralilty of control signals, for activating said pump based on a statistical analysis of control signal timing.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

Barrett et al. (Barrett)	4,870,986	Oct. 3, 1989
Houlihan	5,775,372	July 7, 1998

Appeal No. 2004-1332
Application No. 10/010,691

All of the appealed claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Houlihan in view of Barrett¹.

We refer to the brief and to the answer for a complete discussion of the opposing viewpoints expressed by the Appellant and by the Examiner concerning this rejection.

OPINION

We will sustain this rejection for the reasons set forth in the answer and below.

Houlihan discloses all aspects of the here claimed invention including the use of a preprogrammed controller for activating a hot water circulating pump except that patentee's preprogrammed controller is not disclosed as being based on a statistical analysis of control signal timing as required by appealed independent claim 1. Nevertheless, we agree with the Examiner's conclusion that it would have been obvious for an artisan with ordinary skill to effectuate Houlihan's controller based on a statistical analysis of control signal timing in view of Barrett's

¹ As indicated on page 3 of the brief, the appealed claims will stand or fall together. Accordingly, in assessing the merits of the above noted rejection, we will focus on representative independent claim 1 since this is the broadest claim on appeal. See 37 CFR § 1.192(c)(7)(2003).

teaching of programing a controller or central processing unit for a priority of operation based on a statistical analysis (see lines 49-57 in column 16). In this way, the controller programming desired by Houlihan would have been effected via a parameter, namely, statistical analysis which Barrett evinces was known in the prior art as suitable for this purpose.

In support of his position that the Examiner's rejection is improper, the Appellant argues that "Barrett ... is a non enabling disclosure" (brief, page 4). More specifically, it is the Appellant's position that "[t]he single line statement in Barrett that '[t]he specific priority may be established by the user or based on a statistical analysis' is a mere 'germ' of an idea" (brief, page 4) which would not enable an artisan to practice Barrett's aforequoted objective.

We are unpersuaded by the Appellant's argument for a number of reasons.

First, because the Barrett reference is a US patent, it is presumptively valid and thus enabled. 35 U.S.C. § 282. Further, it is well settled that the burden of proving the inoperability (i.e., nonenablement) of a U.S. patent is not insubstantial. In re Weber, 450 F.2d 1403, 1407, 160 USPQ 549, 553 (CCPA 1969); In re Michalek, 162 F.2d 229, 231-32, 74 USPQ 107, 109 (CCPA 1947). On

the record before us, the Appellant has proffered no evidence whatsoever in support of his assertion that the Barrett disclosure is not enabling. For this reason alone, the Appellant has failed to carry his burden of proving that Barrett's presumptively valid patent is in fact nonenabling.

In addition, the Appellant has erroneously categorized Barrett's column 16 disclosure as "a mere 'germ' of an idea" (brief, page 4). In fact, the Barrett patent contains disclosure beyond column 16 concerning the programming of his controller or central processing unit for a priority of operation. For example, lines 35-53 in column 30 and particularly the paragraph bridging columns 30 and 31 include specific disclosure regarding the use of software for programming patentee's central processing unit so that the functions performed thereby are based on priorities, conditions and limitations imposed by the software.

Finally, the Appellant's nonenablement position is undermined by the fact that his own specification disclosure provides even less teaching than Barrett vis-à-vis effectuating a controller based on statistical analysis. In particular, the most detailed teaching in the subject specification regarding this statistical analysis feature appears on page 7, and this teaching merely states that statistical analysis is performed without specifying any

mechanism by which such performance is achieved. Apparently, at the time this application was filed, the Appellant believed those skilled in the art would be able to practice his invention notwithstanding the aforementioned lack of specificity. From our perspective, if those skilled in the art would be able to effectuate the Appellant's statistical analysis feature based on his specification disclosure, certainly these artisans likewise would be able to practice the statistical analysis feature of Barrett based on patentee's more complete disclosure.

In addition to the above, we observe that the Appellant presents the unembellished statement that "the Barrett...reference does not disclose a controller for activating a pump based on a statistical analysis of control signal timing (see claim 1)" (brief, page 5). Presumably, the Appellant advanced this statement in an attempt to show nonobviousness. However, one cannot show nonobviousness by attacking references individually where the rejection, as here, is based on a combination of references. This is because the test for obviousness is what the combined teachings of the applied references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881-82 (CCPA 1981).

Appeal No. 2004-1332
Application No. 10/010,691

For the reasons set forth above and in the answer, it is our determination that the Examiner has established a prima facie case of obviousness which the Appellant has failed to successfully rebut with argument and/or evidence of nonobviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We shall sustain, therefore, the Examiner's § 103 rejection of claims 1-13 as being unpatentable over Houlihan in view of Barrett.

The decision of the Examiner is affirmed.

Appeal No. 2004-1332
Application No. 10/010,691

No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

BRG/jrg

Appeal No. 2004-1332
Application No. 10/010,691

WALTER A. HACKLER
2372 S.E. BRISTOL, SUITE B
NEWPORT BEACH, CA 92660-0755